



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

| | | | |
|--|----|------------------------|-------------------|
| | | Application No. | 09/528,466 |
| | | Filing Date | March 17, 2000 |
| | | First Named Inventor | Steven R Mitchell |
| | | Art Unit | 3625 |
| | | Examiner Name | Robert M. Pond |
| Total Number of Pages in This Submission | 10 | Attorney Docket Number | 4576P001 |

ENCLOSURES (check all that apply)

| | | |
|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to Group |
| <input checked="" type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment / Response | <input type="checkbox"/> Petition | <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Request for Refund | <input type="checkbox"/> Return Receipt Postcard |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> CD, Number of CD(s) | |
| <input type="checkbox"/> PTO/SB/08 | | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | | |
| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application | <input type="checkbox"/> Remarks | |
| <input type="checkbox"/> Basic Filing Fee | | |
| <input type="checkbox"/> Declaration/POA | | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------|---|
| Firm or Individual name | Jonathan S. Miller, Reg. No. 48,534 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP |
| Signature | |
| Date | November 9, 2004 |

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

| | |
|-----------------------|----------------------|
| Typed or printed name | Lillian E. Rodriguez |
| Signature | |
| Date | November 9, 2004 |

Based on PTO/SB/21 (04-04) as modified by Blakely, Sokoloff, Taylor & Zafman (lwr) 06/04/2004.
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450



FEE TRANSMITTAL for FY 2004

Effective 10/01/2004. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$)

0.00

Complete if Known

| | |
|----------------------|-------------------|
| Application Number | 09/528,466 |
| Filing Date | March 17, 2000 |
| First Named Inventor | Steven R Mitchell |
| Examiner Name | Robert M. Pond |
| Art Unit | 3625 |
| Attorney Docket No. | 4576P001 |

METHOD OF PAYMENT (check all that apply)

Check Credit card Money Order Other None

Deposit Account

Deposit Account Number **02-2666**

Deposit Account Name **Blakely, Sokoloff, Taylor & Zafman LLP**

The Commissioner is authorized to: (check all that apply)

- Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | FeePad |
|---------------------|----------|--------------|----------|------------------------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1001 | 790 | 2001 | 395 | Utility filing fee |
| 1002 | 350 | 2002 | 175 | Design filing fee |
| 1003 | 550 | 2003 | 275 | Plant filing fee |
| 1004 | 790 | 2004 | 395 | Reissue filing fee |
| 1005 | 160 | 2005 | 80 | Provisional filing fee |
| SUBTOTAL (1) | | (\$) | | |

2. EXTRA CLAIM FEES

| Total Claims | Independent Claims | Extra Claims | Fee from below | FeePad |
|--------------|--------------------|--------------|---------------------|--------|
| 53 | 5 | 53 - 5 = 48 | = 0 x 9.00 = \$0.00 | |
| | | | | |
| | | | | |

| Large Entity | | Small Entity | | FeePad |
|---------------------|----------|--------------|----------|---|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 88 | 2201 | 44 | Independent claims in excess of 3 |
| 1203 | 300 | 2203 | 150 | Multiple Dependent claim, if not paid |
| 1204 | 88 | 2204 | 44 | **Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | **Reissue claims in excess of 20 and over original patent |
| SUBTOTAL (2) | | (\$) | | 0.00 |

**or number previously paid, if greater. For Reissues, see below

3. ADDITIONAL FEES

| Large Entity | Small Entity | Fee Description | FeePad |
|--------------|--------------|-----------------|---|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) |
| 1051 | 130 | 2051 | 65 Surcharge - late filing fee or oath |
| 1052 | 50 | 2052 | 25 Surcharge - late provisional filing fee or cover sheet. |
| 2053 | 130 | 2053 | 130 Non-English specification |
| 1812 | 2,520 | 1812 | 2,520 For filing a request for ex parte reexamination |
| 1804 | 920 * | 1804 | 920 * Requesting publication of SIR prior to Examiner action |
| 1805 | 1,840 * | 1805 | 1,840 * Requesting publication of SIR after Examiner action |
| 1251 | 110 | 2251 | 55 Extension for reply within first month |
| 1252 | 430 | 2252 | 215 Extension for reply within second month |
| 1253 | 980 | 2253 | 490 Extension for reply within third month |
| 1254 | 1,530 | 2254 | 765 Extension for reply within fourth month |
| 1255 | 2,080 | 2255 | 1,040 Extension for reply within fifth month |
| 1404 | 340 | 2401 | 170 Notice of Appeal |
| 1402 | 340 | 2402 | 170 Filing a brief in support of an appeal |
| 1403 | 300 | 2403 | 150 Request for oral hearing |
| 1451 | 1,510 | 2451 | 1,510 Petition to institute a public use proceeding |
| 1452 | 110 | 2452 | 55 Petition to revive - unavoidable |
| 1453 | 1,370 | 2453 | 685 Petition to revive - unintentional |
| 1501 | 1,370 | 2501 | 685 Utility issue fee (or reissue) |
| 1502 | 490 | 2502 | 245 Design issue fee |
| 1503 | 660 | 2503 | 330 Plant issue fee |
| 1460 | 130 | 2460 | 130 Petitions to the Commissioner |
| 1807 | 50 | 1807 | 50 Prosessing fee under 37 CFR 1.17(q) |
| 1806 | 180 | 1806 | 180 Submission of Information Disclosure Stmt |
| 8021 | 40 | 8021 | 40 Recording each patent assignment per property (times number of properties) |
| 1809 | 790 | 1809 | 395 Filing a submission after final rejection (37 CFR § 1.129(a)) |
| 1810 | 790 | 2810 | 395 For each additional invention to be examined (37 CFR § 1.129(b)) |
| 1801 | 790 | 2801 | 395 Request for Continued Examination (RCE) |
| 1802 | 900 | 1802 | 900 Request for expedited examination of a design application |

Other fee (specify) _____

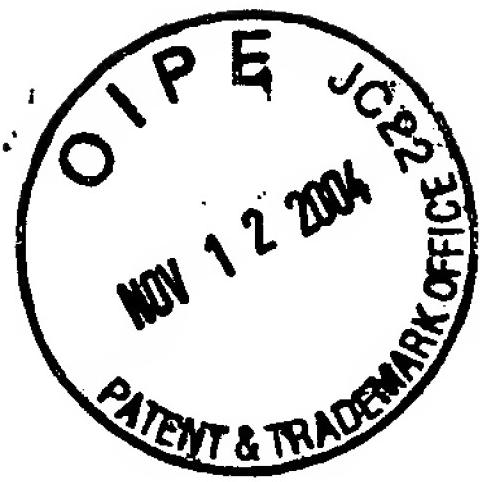
* Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$)

SUBMITTED BY

| | | | | | |
|-------------------|--------------------|-----------------------------------|--------|-----------|----------------|
| Name (Print/Type) | Jonathan S. Miller | Registration No. (Attorney/Agent) | 48,534 | Telephone | (310) 207-3800 |
| Signature | | | | Date | 11/09/04 |



AF/3625
ETW

Attorney's Docket No. 4576P001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Steven R. Mitchell

Serial No. 09/528,466

Filed: March 17, 2000

For: A PURCHASE COORDINATOR FOR
ELECTRONIC COMMERCE

Examiner: Robert M. Pond

Art Unit: 3625

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF

Dear Sir:

Applicant submits the following Reply Brief pursuant to 37 C.F.R. § 41.41.

STATEMENT OF ISSUES

The Examiner notes that Issue B in the Statement of Issues is incorrect. The Examiner correctly notes that the rejection of the claims is based on § 102(e) and not § 102(b). As the Examiner correctly surmises, this is a typographical error in the Statement of Issues. The subsequent discussion of this rejection in the Arguments Section is correctly based on § 102(e) and not § 102(b).

GROUPING OF CLAIMS

The Examiner disagrees with the Appellant's statement that the identified groups of claims do not stand or fall together. However, each of these groups of claims have a separate ground for rejection. Thus, the claims of any one of these groups may be found patentable separately from the claims of the other groups. For example, the Examiner has argued that the Declaration does not establish conception of certain claims. Thus, it is possible that claims in different groups may be

found to be patentable because the Declaration is sufficient for those groups while other groups may have their rejections affirmed because the declaration is not sufficient for claims in those groups.

ARGUMENT

The Examiner has raised new points of argument in the Examiner's Answer regarding the non-statutory subject matter rejection of claims 1-41 and 53 and the sufficiency of the Declaration relating to conception and diligence. The Examiner sets forth the following arguments in the Examiner's Answer:

Claims 1-41 and 53 are not tied to any technological art; a reason as to why Documents A-D, L and M were not previously presented has not been provided; the Declaration under 37 C.F.R. § 1.131 contains gaps in diligence; insufficiency of Document A as evidence of conception. In response to these points of arguments, the Applicant replies as follows:

I. **Regarding the Rejection for Claims 1-41 and 53 Under 35 U.S.C. § 101**

Appellant notes that the Examiner's Answer ignores the arguments set forth in Section VIII.A of the Appeal Brief. Namely, the Examiner has failed to set forth how the Examiner is construing the claims as required by MPEP § 2106. The Examiner has not responded to the Applicant's argument set forth in the Appeal Brief discussing the holding of *State Street Bank and Trust Company v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998). Instead, the Examiner has cited a case, *ex parte Bowman*, 61 USPQ2d 1669, that the Examiner acknowledges is not precedential. Obviously, a non-precedential opinion has no authority. Further the analysis set forth in *Bowman*, which the Examiner purports to reference for its analysis is inapposite to the present case.

Bowman discusses an application where the invention "as disclosed and claimed" was written by the Applicant in that case such that it "carefully avoided tying the disclosed and the claimed invention to any technological art or environment." That is not the case with the present application. The disclosure of the present application clearly sets forth the context of the claimed

invention. Namely, that the claimed methods operate in the context of a computer environment to manipulate data. Thus, the claims which are interpreted in light of this disclosure clearly have an application in the technological arts and meet the standards as set forth in *State Street*.

II. **Issues Common to the Rejection of Groups I-IV Explanation of New Documents in Support of the Declaration**

Appellant notes that the Examiner has still not provided any authority for requesting an explanation as to why documents A-D, L and M were not utilized in preparing previous Declarations. It is unclear to the Appellant what the relevancy is for this line of questioning. As set forth in the Appeal Brief, the selection of documents used in support of a Declaration is at the Appellant's discretion. Appellant is not aware of a requirement that all the documents available to the Appellant be utilized in support of a Declaration.

Further, Appellant on multiple occasions stated to the Examiner that due to the history of the development of the invention many of the documents relating to the early stages of the invention and its conception are located and stored in machines that are no longer in use and difficult for the Appellant to search through to find relevant documents. Previously submitted Declarations utilized documentation made available at the time by the Appellant's search through this disorganized set of stored file. Due to the bulk and poor state of these files, identifying files relevant or useful for supporting a Declaration was a tedious and time consuming task. Because previous Declarations were not admitted by the Examiner, continued search for supporting documents was made thereby eventually uncovering documents A-D, L and M. Appellant provides this information for the sake of minimizing the present issues in the Appeal. Appellant restates that he believes that the Examiner has failed to set forth any rationale for requiring this information. In fact, the Examiner has been made aware, on multiple occasions during telephone conversations, of the difficulty Appellant had in locating and identifying files relating to this invention.

III. Gaps in Diligence

In page 8 and 9 of the Examiner's Answer, the Examiner sets forth a lengthy list of cases and summaries of opinions in these cases related to the requirements for a 37 C.F.R. § 1.131 Declaration. However, the Examiner does not provide any discussion as to how these requirements are not met by the present declaration.

The Examiner seems to indicate on page 9 of the Examiner's Answer that the Examiner was not able to ascertain the relevance of the evidence presented in the declaration. The Examiner states that "the Appellant did not provide the Examiner with annotation that would have been useful to the Examiner in examining the evidence." However, the Declaration clearly set forth what the relevance of each of the documents presented in support was and identified each of these documents. It is unclear to the Appellant for which aspect of these documents the Examiner requires further explanation. In addition to the discussion of the documents in the declaration, Appellant attempted to explain to the Examiner during the telephonic interview the relevancy of each of the documents that were eventually provided in support of the Declaration. Despite this explanation, the Examiner seems unable to understand the documents provided. However, these documents should be easily understandable to one of ordinary skill in the art as they are flow charts and computer code and each of these document types are commonly encountered by those of ordinary skill in the art.

IV. Conception

The flow chart in Document A was provided as evidence of conception. The Examiner asserts that Document A does not demonstrate conception in regard to claims 18, 35 and 42. The Examiner states that the elements of "selecting one of a plurality of distributors to fill the order" is not depicted. However, this language is not limited to the use of a coordinator to select one of a plurality of distributors to fill an order. Rather, the selection of a distributor may be by a customer as depicted in Document A where the box related to the customer finding website shows conception of this element of claims 18, 35 and 42.

The Examiner states that claims 12 and 29 are not supported by Document A because they include the elements of debiting a total value after an order shipped. The Examiner states this is not depicted because this step is depicted as a "parallel step." However, Document A clearly shows a customer credit card being charged and the payment of a manufacture, distributor or retailer and/or Internet company lower on the page and thus occurring later in time than the box related to the shipment of the product. One of ordinary skill in the art would understand that the box representing the product shipment being placed higher in the page indicates that the customer credit card is charged subsequent to the product shipping. Thus, Document A is sufficient for evidencing conception of this element of claims 12 and 29.

In regard to claims 4-6, these claims depend from independent claim 1, which the Examiner has not identified as having any issue with regard to conception based on Document A. Thus, if claim 1 is found to be patentable over the cited references the dependent claims will also inherently be patentable.

In regard to claim 53, the Examiner states that Document A does not depict "receiving acknowledgement when each order ships" and "selecting one of a plurality distributors to fill each of the orders." Selection of the distributors is addressed above in regard to claims 18, 35 and 42. One of ordinary skill in the art would understand that this is standard practice in the field. Document A in the bottom two boxes shows that after the product has been shipped, shipments and related invoices are tracked. The generation of invoices and tracking information clearly shows conception of "receiving acknowledgement when each order ships" to one of ordinary skill in the art.

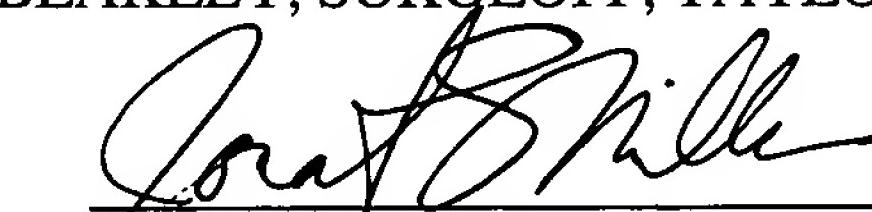
CONCLUSION

For the reasons specified above, the rejection of all claims should be overturned and the claims allowed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 11/9/04, 2004

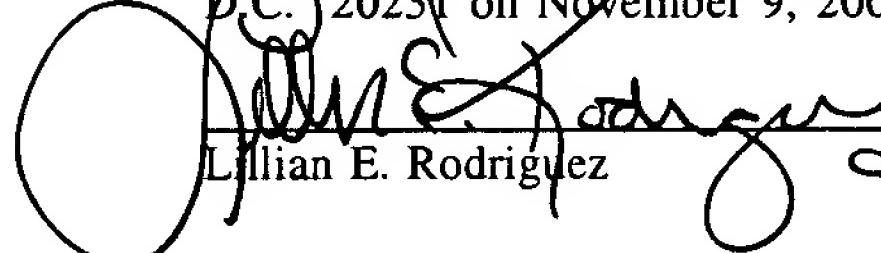


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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited as First Class Mail with the United States Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on November 9, 2004.



Lillian E. Rodriguez

11-9-04
November 9, 2004